

**Remark:****(A) The display tag of Rahmey, Markman and Banks are not positioned vertically above or extends along any supporting arm of a garment hanger:**

This discussion applies to independent claims 10, 28 and 31. The display area of the tags of Rahmey, Markman and Banks are positioned at a "non-supporting region" commonly known by a person having ordinary skill in the garment hanger industry to be the "medial portion" of a garment hanger. This "medial portion" neck area had already been clearly specified in great detail in many locations of the specification (e.g. page 3, lines 17 and 23; page 4 line 12; whole second paragraph of page 7; page 8 line 20; portion 131 of Fig. 2; portion 224 of Fig. 5 and 306 of Fig. 6). Claims 10, 28 and 31 explicitly recite the supporting arms are the areas that support the garment. It is respectfully submit that any of Rahmey, Markman or Bank disclose the characteristics of the supporting arms recited in claims 10, 28 and 31 to justify a rejection either under 35 U.S.C. 102(b) or 35 U.S.C. 103(a).

**(B) New ground of rejection:**

The latest office was a result of a new search. There were numerous new rejections. Some of these new grounds rejections were applied to claims that had not be amended. For example, new ground of rejection for claim 28 under 35 USC 112.

(a) Claim 28 replaced original claim 5 in the RCE filing dated 02/25/2005.

(b) This description was provided in the 02/25/2005 RCE filing according to a previous telephone discussion with the examiner as an acceptable compromise to replace the term "on top of" the hanger arms.

(c) This claim was allowed in the later office action dated 03/16/05.

(d) This characteristic was never amended after it was first submitted in the RCE filing dated 02/25/2005 and allowance 03/16/05 and 11/29/05.

(e) The applicant renumber the allowed claim 5 into claim 28 so as to regroup other characteristics of the invention into this allowed claim (allowed on 03/16/05), please refer to page 7, of applicant's response dated 11/17/05.

(f) Claim 28 (previous claim 5) remain allowed in the subsequent office action dated 11/29/2005.

(g) The subsequent office action dated 02/15/2006 had never reject claim 28 according to 35 USC 112 in view of the characteristic described in (a) above.

(h) The latest office action dated 09/06/2006 is the **FIRST** time the above (a) mentioned characteristic of claim 28 to be rejected 35 USC 112.

Since the characteristic in question had never been amended after it was introduced in the RCE application, and that it had never been rejected under the new 112 ground of rejection and also the 102(b) rejection over Banks in all previous office actions (in which two of the office actions claim 28 had already been allowed); technically the latest 35 USC 112 rejection and the latest 35 USC 102(b) rejection over Banks are new grounds of rejection first introduced not due to applicant's amendment. Therefore the final status of the office action dated 09/06/2006 is respectfully requested to be withdrawn.

**(C) Incomplete and premature office action**

There were some claims rejected without fully disclosing the rational behind. For example, independent claim 31 was rejected under 35 USC 103(a) as being anticipated by Markman. However, the paragraph 13, in page 5 of the office action supposed to provide reasons for the rejection described subject matters not relevant to claim 31 at all.

37 CFR 1.104 requires an office action to be complete to explain the grounds of rejection. Since the reason supporting the ground of rejection of claim 31 was not provided, the final status of the office action dated 09/06/2006 is premature and respectfully requested to be withdrawn.

**(D) Claim 35 is rejected under 35 U.S.C. 112**

The applicant wish to express his most sincere to the examiner for pointing out this error. Claim 35 is amended to depend on claim 32 instead of claim 31. All lack of antecedent error are now corrected.

**(E) Correction of Drawings:**

Page 3, point 7 of the office action dated -9/06/2006 objected the drawings for failing to show a hang tag extending along one of the supporting arms. Corrected drawing was requested by the office action. Please refer to the discussion in (F)

below and advice if correction of drawing as indicated by the office action is required.

- (F) **28-35 is rejected under 35 U.S.C. 112 for the drawings being failed to demonstrate how a hang tag positioned vertically above one of the supporting arm can be achieved.**

In the telephone conference dated 12/13/2006, the applicant argued that the claim adequately recites the two key characteristics of the invention (e.g. for the example of claim 31 – (a) a display tag secured behind said garment hanger, and (b) said display tag further have a substantial display area positioned vertically above and extending along a supporting arm). Whether the display area to be on top of one or both supporting arms is simply a matter of choice under the enabling requirement according to common sense to a person having ordinary skill in the art as allowed by the law. In the telephone conference the examiner indicated he can reconsider this position if the applicant is able to locate reference in the MPEP to support this position. The applicant respectfully provides the following three points for the consideration of the examiner:

(1) The applicant respectfully “unofficially” submit the reference sketch as shown in appendix A of this response showing how a display area positioned vertically above a supporting arm according to the common sense of a person having ordinary skill in the art according to the teaching of the disclosure of the subject invention – simply remove the display area vertically on top of the second arm.

(2) Per the request of the examiner during the telephone interview dated 12/13/2006, the applicant respectfully submits the following quotation of MPEP 2164.08 supporting the point of the applicant for the reconsideration of the examiner as follow:

*2164.08 Enablement commensurate in scope with the claims:  
All questions of enablement are evaluated against the claimed subject matter. The focus of the examination inquiry is whether everything within the scope of the claim is enabled.....The Federal Circuit has repeatedly held that “the specification must teach those skill in the art how to make and use the full scope of the claimed invention without ‘undue experiments’.” In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not*

*everything necessary to practice the invention need to be disclosed.....If a reasonable interpretation of the claim is broader than the description in the specification, it is necessary for the examiner to make sure the full scope of the claim is enabled. Limitations and examples in the specification do not generally limit what is covered by the claims.*

According to the sketch in Appendix A above, it is submitted that any ordinary person having ordinary knowledge in the art should have adequate know how to implement the above two inventive characteristics claimed. That person is easy to apply the two claimed characteristics either to one or both hanger arms.

(3) In order to further cooperate with the professional view point of the examiner, independent claims 28 and 31 are now further amended for the display area to position vertically above/extending along "at least one" of said supporting arms. There is subtle difference between the amended claim and the original claim. The existing specification satisfies the requirement of the amended claim language but not the original claim. Technically the amended claims now satisfy the disclosure requirements of the patent law – to show a preferred embodiment that satisfies the "at least one" characteristic.

The examiner is requested to inform the applicant if claims 28 and 31 are acceptable as amended to overcome the rejection of 35 U.S.C. 112 (and also the drawing objection) or if the sketch shown in Appendix A is not treated as a new matter that can be submitted to overcome the objection of drawings and overcoming the rejection 35 U.S.C. 112 at the same time. Although the examiner is also respectfully solicited to allow the subject claims as amended, the examiner is invited to propose further amendment pursuant to MPEP 707.07(j) for the subject claim to overcome the 35 U.S.C. 112 rejection, without narrowing the scope of the subject claim.

**(G) Claims 10 is rejected under 35 U.S.C. 103(a) under Markman**

Markman failed to disclose nor teach the following four characteristics recited by the subject claims:

(1) "A garment hanger retail package":

The office action erred in treating the claim as "A system comprising..." There are always some difference in between "A system comprising..." and "A garment

hanger retail package comprising...." This characteristic significantly define the subject claim over Markman because the structure of Markman will **NOT WORK** for it's intended application when two or more hangers are packaged together.

(2) Markman failed to satisfy the characteristic "*behind*" recited in the subject claim because it's tag has a significant portion positioned "in front of" said second garment hanger and "*behind*" said first garment hanger.

(3) As discussed in Remark (A) above, Markman disclosed a display area position around an area defined to be the "medial portion" of a garment hanger. The display area of Markman does not extended along the extension of said supporting arms as claimed.

(4) According to the telephone conference dated 12/13/2006, claim 10 is now allowable as amended to include the wording "*wherein said retail package further comprising means to combine said garment hangers and said display tag to form said garment hanger retail package*".

Allowance of claim 10 is therefore respectfully requested.

**(H) Claims 14 and 18 are rejected under 35 U.S.C. 102(b) under Rahmey**

(1) Rahmey failed to disclose a display tag positioned "*behind*" said garment hanger to justify a rejection under 35 U.S.C. 102(b).

(2) Rahmey failed to provide a "substantial frontal view" of the hanger. Claims 14 and 18 had been previously allowed in the office action dated 11/26/2004; 02/22/2005; 03/16/2005 09/02/2005 and 11/29/2005 under the characteristic that Rahmey did not disclose a substantial frontal view of the retail hanger. Under the previous flip flop of the office action, the applicant and the examiner reached a compromise to amend the term to "substantial full frontal view" so as to describe the almost full frontal view looking when the same color fastener and folded flap are taken into account.

(3) According to the telephone conference dated 12/13/2006, claim 14 and 18 are allowable as amended to have the display tag to be "*secured behind*" said garment hanger.

**(I) Claims 14 and 18 are rejected under 35 U.S.C. 102(b) under Banks**

(1) According to the side view drawings of Banks, comparing the vertical positions of the tag and the hanger wire, obviously the display tag of Banks locates at the

front side of the hanger instead of behind the hanger as claimed so as to justify a rejection under 35 U.S.C. 102(b).

(2) Claim 14 is further rejected under 35 U.S.C. 103(a) according to Banks (the fasteners). It means the office action explicitly admits that there are structural differences between Banks and claim 14.

(3) For claim 18, it is obvious that the folded flap of display tag of Banks is engaged with the hanger body instead of the suspension member as claimed to justify a rejection under 35 U.S.C. 102(b).

(4) According to the telephone conference dated 12/13/2006, claim 14 and 18 are allowable as amended to have the display tag to be "secured behind" said garment hanger.

**(J) Claims 18 is rejected under 35 U.S.C. 103(a) under Banks**

(1) According to the side view drawings of Banks, comparing the vertical positions of the tag and the hanger wire, obviously the display tag of Banks locates at the front side of the hanger instead of behind the hanger as claimed. This structure gives Banks more smooth frontal display area. If the orientation of Banks is overturned for the display area to locate "behind" the hanger as claimed, the flap 13 and 16 will reduce the smooth frontal display area of Banks and make the design significantly inferior as compared with the existing design of Banks. According there is no motive to modify the design of Banks to meet the recited characteristics of the subject claims, for the display tag to position behind the garment hanger.

(2) According to the telephone conference dated 12/13/2006, claim 18 is allowable as amended to have the display tag to be "secured behind" said garment hanger.

**(K) Claims 31 is rejected under 35 U.S.C. 102(b) under Banks**

(1) Per the discussion of (A) above, the display tag of Banks is positioned around the "medial portion" of a hanger instead of vertically above the supporting arm as claimed.

(2) Claim 31 is further rejected under 35 U.S.C. 103(a) according to Banks. It means the office action explicitly admits that there are structural differences between Banks and claim 31 and the rejection under 35 U.S.C. 102(b) should be withdrawn.

(3) According to the telephone conference dated 12/13/2006, claim 31 is allowable as amended to have the display tag to be "secured behind" said garment hanger.

**(L) Claims 31 is rejected under 35 U.S.C. 103(a) under Banks**

(1) Per the discussion of (A) above, the display tag of Banks is positioned around the "medial portion" of a hanger instead of vertically above the supporting arm as claimed.

(2) If the tiny area of the tag of Banks positioned "on top" of the wire is considered as the "substantial display area", obviously this tiny areas are not adequate to display the desire message 15 "John Doe Pressing" of Banks. Accordingly Banks does not teach switching the display area from 12 to the tiny strips of the tag on top of the hanger wire.

(3) According to the telephone conference dated 12/13/2006, claim 31 is allowable as amended to have the display tag to be "secured behind" said garment hanger.

**(M) Claims 31 is rejected under 35 U.S.C. 103(a) under Markman**

(1) The office action dated 09/06/2006 did not state how claim 31 was rejected under 35 U.S.C. 103(a) according to Markman. 37 CFR 1.104 requires an office action to be complete to explain the grounds of rejection. Since the reason supporting the ground of rejection of claim 31 was not provided, the final status of the office action dated 09/06/2006 is premature and respectfully requested to be withdrawn.

(2) Even when claim 31 is compared with the disclosure of Markman, it is respectfully submit that per the discussion of (A) above, the display tag of Banks is positioned around the "medial portion" of a hanger instead of vertically above the supporting arm as claimed. Markman did not show any motive to relocate the display tag from the "medial portion" of the hanger to the region behind the hanger and vertically above a supporting arm.

(3) According to the telephone conference dated 12/13/2006, claim 31 is allowable as amended to have the display tag to be "secured behind" said garment hanger.

**(N). Six Month statutory period:**

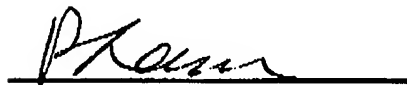
**The examiner is respectfully reminded that the six month statutory period from the mailing date of the final office action ends on March 5, 2007.**

Respectfully submitted,



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I hereby certify that this correspondence is being fax to the United States Patent and Trademark Office via the fax number 571-273-8300 on January 2, 2007.



Peter Ar-Fu Lam  
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# Appendix 1

Figure 1a

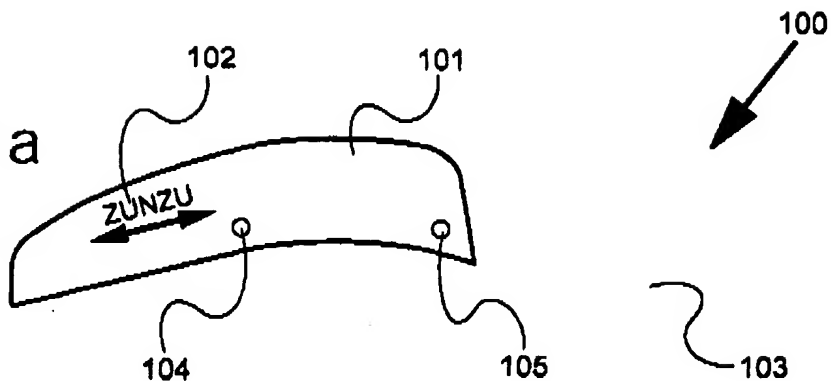


Figure 2a

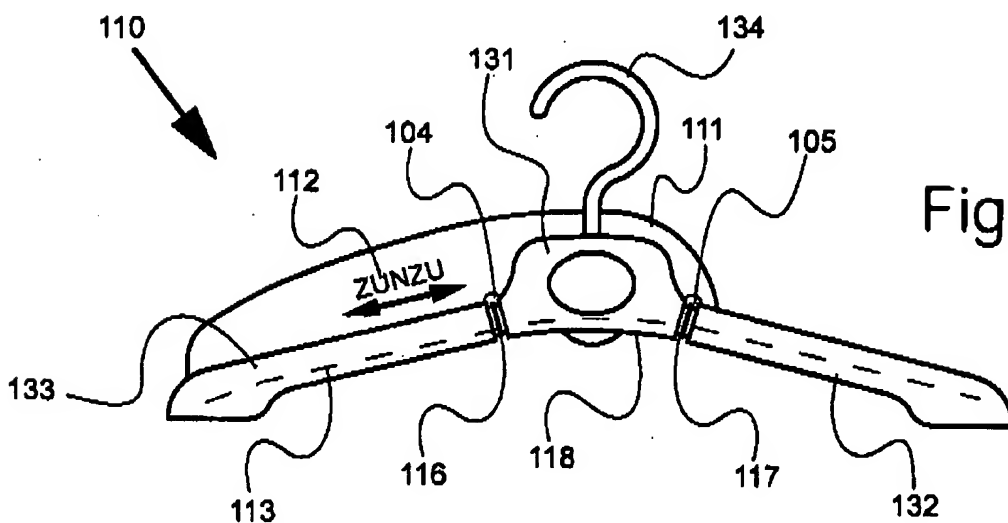


Figure 3a

